

# SIEMENS

PATENT  
Attorney Docket No. 2003P14536US

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventor:	R. Martin et al.	)		
		)	Group Art Unit:	3663
Serial No.:	10/669,862	)		
		)	Examiner:	E. Pipala
Filed:	September 24, 2003	)		

Title: TURBINE COMPONENT TRACKING SYSTEM

Commissioner For Patents  
PO BOX 1450  
Alexandria, VA. 222313-1450

Sir:

### APPELLANT'S REPLY BRIEF

Pursuant to 37 C.F.R. § 1.193(b), this Reply Brief is responsive to the Examiner's Answer mailed September 10, 2007. This is not a substitute Appeal Brief. Any ground for rejection in Examiner's Answer that is not refuted herein is considered by Appellant to have been sufficiently argued in the Appeal Brief, such that no further comment is needed herein. Arguments herein focus on errors in the Examiner's answer.

#### The Examiner's "First and Foremost" Contention

The Examiner's substantive Answer begins on page 15 (paragraph 10) and contends: "First and foremost, **the Examiner does not necessarily expect to bodily incorporate the computer chips of Henry et al. into the monitoring system of Herron et al. . . . The Examiner's premise is that** the teaching of Henry et al. with respect to the use of turbine component *part numbers* and *serial numbers* can easily be implemented within a software database type turbine monitoring system of Herron et al." (italics in original, bold added).

To the extent the Examiner's interpretation of the prior art remains to bodily incorporate the computer chips of Henry into the monitoring system of Herron, as explained in the Appeal Brief, the claimed invention teaches away from such bodily incorporation.

To the extent the Examiner's new interpretation of the prior art incorporates the claimed indicia into a software database, this new interpretation does not disclose or suggest the elements recited in independent claim 8, which requires:

marking a plurality of turbine components with indicia applied to a surface of the components, and using the uploaded data at the central processing station to track desired aspects of the marked turbine components

It is incumbent for the Examiner to identify prior art that discloses or suggests each and every limitation of the claimed invention. As emphasized throughout prosecution, there is no teaching or suggestion in Henry, Herron or the prior art of Applicant's solution to the particular problem detailed in the Background of the Invention section of the application. The Examiner is respectfully urged to avoid the insidious temptation of hindsight to conclude that the inventive features taught by Applicant are merely obvious design considerations. Only Applicant's specification teaches the particularly claimed combination, not the prior art. Applicant respectfully submits that it is improper for the Examiner to rely upon the level of ordinary skill in the art to selectively pick and choose certain features not found in the prior art in hindsight in order to recreate what the Examiner was unable to find – the claimed combination.

The level of skill in the art is a prism or lens through which a judge or jury views the prior art and the claimed invention. This reference point prevents these deciders from using their own insight or, worse yet, hindsight, to gauge obviousness. **Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment.** See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one or ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references or record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.').

*Al-Site Corp. v. VSA Int'l., Inc.*, 174 F.3d 1308, 1324, 50 U.S.P.Q.2d 1161, 1177 (Fed. Cir. 1999) (emphasis added).

This is not one of those rare cases where the level of skill can supply a missing claim limitation or suggestion to modify the prior art. This is especially true since: (1) it is the inventive features of the claimed invention, as detailed in the Background of the Invention section of the application, that are not disclosed or suggested by the prior art, and (2) the Examiner's combination, when properly considered as a whole, teaches away from the claimed invention.

Moreover, the Examiner's position is inconsistent with the Office's Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex*. In particular, Section IIIA of the Guidelines explains that to reject a claim based on the rationale of combining prior art elements according to known methods to yield predictable results, the Examiner must make "a finding that the prior art included each element claimed, although not necessarily in a single prior art reference". Here the Examiner has failed to make such a finding. The closest the Examiner comes to making this finding is on page 17 with the contention that the above limitation is "inherent". However, the Examiner has failed to meet the burden of proof requirements required in MPEP 2112 IV: "to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference". To the contrary, the bulk of Examiner's remaining argument serves as an admission that the above limitation is not found in the cited references.

Therefore, the Section 103 rejection must be withdrawn.

#### Claim 21

Claim 21 recites that the turbine components are marked with a bar code. In contrast, the Henry discloses a serial number (Col. 3, line 65). In the Restriction Requirement para 2, the Examiner determined that marking with a bar code (species A) and marking with a serial number (species B) were patentably distinct species. See e.g. MPEP 808.1(a) "A requirement for restriction is permissible if there is a patentable difference between the species as claimed."

Now, in rejecting claim 21, the Examiner contends that this difference is obvious. Not only does the Examiner provide no explanation as to why reversal of his earlier determination is warranted, but the Examiner does not withdraw the species restriction. **It is clearly improper for the Examiner to maintain that the different species are patentably distinct yet obvious.**

Applicants respectfully submit that the Examiner's initial determination was proper and that the Examiner's subsequent determination was improper. Therefore, Applicant respectfully requests allowance of claim 21.

Conclusion

For the reasons provided in Applicant's previously filed Office Actions, expanded upon in Applicant's Appeal Brief, and highlighted in this Reply Brief, Applicant respectfully submit that the rejections set forth in the final Office Action are inapplicable to the pending claims. The honorable Board is therefore respectfully requested to reverse the final rejection of the Examiner and to remand the application to the Examiner with instructions to allow the pending claims. Please grant any extensions of time required to enter this paper. Please charge any appropriate fees due in connection with this paper or credit any overpayments to Deposit Acct. No. 19-2179.

Respectfully submitted,

Dated: 10/17/07

By: \_\_\_\_\_



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